

REMARKS

Claims 1, 4 and 9 have been amended to make an editorial change, and claim 9 has also been amended to correct a typographical error, in which "more that 1/1000 seconds or less" has been correct to "1/1000 seconds or less" in connection with the recited Class D.

Entry of the above amendment is respectfully requested.

Rejection of Claims 1-11 under 35 U.S.C. § 103 (a)

The Examiner has rejected Claims 1-11 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,783,373 to Mydlarz, *et al.* ("Mydlarz '373") or U.S. Patent No. 5,783,378 to Mydlarz, *et al.* ("Mydlarz '378"), in view of Edwards '601.

A. The Examiner's Position

The Examiner has maintained the rejection as originally set forth on pages 4 and 5 of the Non-Final Office Action of June 22, 2004.

Further, the Examiner states that Applicants' arguments are not persuasive. The Examiner argues that she did not apply hindsight reasoning in rejecting Claims 1-11 because she relied on knowledge which was within the level of ordinary skill at the time the claimed invention was made, and which did not include knowledge gleaned only from the applicant's disclosure, so her reconstruction of the present invention is proper.

In order to support her contention, the Examiner relies on Edwards '607 as teaching that the presence of a high iodide region within a high chloride grain and an Ir doped bromide epitaxy on a high chloride grain can increase the speed/sensitivity of the grains/emulsion. The Examiner

asserts that, based on these teachings of Edwards '607, one of ordinary skill in the art would have been motivated to incorporate these features into a grain with the expectation of achieving these advantages.

B. Applicants' Response

Applicants respectfully traverse this rejection because Mydlarz '373 and '378 "teach away" from the claimed invention. A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness. Further, where references teach away from their combination, it is improper to combine the references. In re Graselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

In this regard, Applicants note that Mydlarz '373 and '378 specifically teach that the silver forming selected site epitaxy is not part of the silver halide grains. *See, e.g.*, col. 15, line 61 to col. 16, line 7 in Mydlarz '373 and the corresponding disclosure in Mydlarz '378. Thus, Applicants submit that Mydlarz '373 and '378 "teach away" from incorporating the teachings of Edwards '607, *i.e.*, to dope Ir in epitaxy.

Accordingly, Applicants submit that the present invention is not obvious over Mydlarz '373 or '378 in view of Edwards '601, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

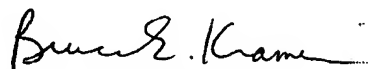
AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 10/642,583

Attorney Docket No. Q76907

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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